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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPEAL FROM THE EXAMINER TO THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	David H. HANES
Serial No.:	09/911,017
Filing Date:	July 20, 2001
Group Art Unit:	2173
Examiner:	Zhou, Ting
Docket No.:	10010903-1
Title:	SYSTEM AND METHOD FOR SCENE DETECTION INFORMATION STORAGE

MAIL STOP: APPEAL BRIEF-PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

REPLY BRIEF

Applicant respectfully submits this Reply Brief in response to the Examiner's Answer mailed June 1, 2005, pursuant to 37 C.F.R. § 1.193(b).

SECTION (6) OF THE EXAMINER'S ANSWER

The Examiner indicates in the Examiner's Answer that Applicant has failed to include a section reciting the issues (Examiner's Answer, page 2). Applicant respectfully refers the Examiner to 37 C.F.R. §§ 41.37, effective September 13, 2004, which generally states that the appeal "brief shall contain the following items under appropriate headings and in the order indicated." Further, 37 C.F.R. § 41.37(c)(1)(vi) recites the following:

> *Grounds of rejection to be reviewed on appeal.* A concise statement of each ground of rejection presented for review.

(emphasis in original). Applicant also respectfully refers the Examiner to Rules of Practice Before the Board of Patent Appeals and Interferences, 69 Fed. Reg. 49960, 49962 (2004), which under section (8) thereof states:

> In paragraph (c)(1)(vi), a concise statement listing each ground of rejection presented for review is required rather than issues for review. An example of a concise statement is "Claims 1 to 10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. X."

Thus, Applicant respectfully submits that Applicant's Appeal Brief complies with the provisions of 37 C.F.R. § 41.37 in that Applicant's Appeal Brief contains a concise statement of each ground of rejection presented for review (at least at page 3 of Applicant's Appeal Brief).

SECTION (7) OF THE EXAMINER'S ANSWER

In the Examiner's Answer, the Examiner indicates that Claims 1-20 are considered to stand or fall together because Applicant's Appeal Brief did not include a statement regarding the grouping of claims and reasons for support thereof in compliance with 37 C.F.R § 1.192(c)(7) (Examiner's Answer, page 3). Applicant respectfully refers the Examiner to 37 C.F.R. § 41.37(c)(1)(vii), effective September 13, 2004, which sets forth the requirements for separately arguing each claim and/or group of claims. For example, 37 C.F.R. § 41.37(c)(1)(vii) recites:

> Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. . . . Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number.

Applicant also respectfully refers the Examiner to Rules of Practice Before the Board of Patent Appeals and Interferences, 69 Fed. Reg. 49960, 49962 (2004) which under section (9) thereof states: "The grouping of claims requirement set forth in former Rule 192(c)(7) is removed."

Applicant submits that Applicant's Appeal Brief is in compliance with 37 C.F.R. § 41.37. For example, Applicant's Appeal Brief has set forth Claims 1-20 as a group (at least at page 4 of Applicant's Appeal Brief).

SECTION (11) OF THE EXAMINER'S ANSWER

In support of the Examiner's position that *Dimitrova* discloses the limitations of the claims presented on appeal, the Examiner states that "*Dimotrova* explicitly states, on column 2, lines 42-45, that 'the selected area for the visual index may occur anywhere in the file, and may be reserved by a system automatically'" (Examiner's Answer, page 4). The Examiner then states: "In other words, a portion or area of the tape may be automatically reserved by the system for storing a visual index instead of being used for recording" (Examiner's Answer, page 4). Applicant respectfully presents an additional portion of *Dimitrova* not recited by the Examiner:

> Both tapes require a predetermined portion at a selected area on the tape, in this example, the beginning for ease of use, to allow a visual index to be created. For the present example, thirty seconds of "blank" or overwrittable [sic] tape is desired. For a file, the selected area for the visual index may occur anywhere in the file, and may be reserved by a system automatically or manually selected by a user.

(*Dimitrova*, column 2, lines 41-45) (emphasis added). Thus, the automatic location selection for the visual index of *Dimitrova* referred to by the Examiner appears to relate to a location in a file and not a location on a tape as asserted by the Examiner. For example, *Dimitrova* recites that "[f]or a file, the selected area for the visual index may occur anywhere in the file, and may be reserved by a system automatically or manually selected by a user" (e.g., at the beginning of the file, at the end of the file, etc.)(*Dimitrova*, column 2, lines 41-45) (emphasis added). Thus, the portion of *Dimitrova* referred to by the Examiner appears to be directed toward a location in a file where an index may be created and not a medium onto which the file is stored.

Moreover, even if the *Dimitrova* system is considered to automatically select a portion of a tape where a visual index is to be created, which Applicant submits is not disclosed by *Dimitrova*, the selected area on the tape for the visual index of *Dimitrova* comprises at least a portion of the recordable capacity of such tape. In the Examiner's Answer, the Examiner states "since the [*Dimitrova*] system automatically allocates, or reserves a portion of the tape for storing the visual index, that portion of the tape is not part of the recordable capacity, but rather a part of the tape that is set aside specifically for storing media information, i.e., the visual index" (Examiner's Answer, page 6). Applicant respectfully disagrees. *Dimitrova* does not disclose or even suggest, nor has the Examiner explicitly identified any such portion of *Dimitrova*, that any such portion of a tape containing an index would not be otherwise used for recording other content if such visual index was not present. To the contrary, even if a portion of the tape is "set aside" for containing a visual index (e.g., "the beginning for ease of use"), such portion of the tape is still utilizing a portion of the recordable capacity of such tape. Accordingly, *Dimitrova* does not disclose or even suggest the limitations of the claims presented for appeal.

Further, in the Examiner's Answer, the Examiner refers to Applicant's example in Applicant's Appeal Brief that indicates that if a tape has a finite recording capacity "X," a visual index recorded on such tape will utilize at least a portion of such capacity "X" (Examiner's Answer, pages 5-7, referring to Applicant's Appeal Brief, page 6). The Examiner appears to indicate that if a portion of a tape "Y" is set aside for storing a visual index, the recordable capacity of such tape is "X-Y," and

that if a user desires not to include a visual index, the recordable capacity of such tape remains "X-Y." Applicants respectfully submit that the Examiner's position is unsupported. *Dimitrova* does not disclose or even suggest that if a visual index is not created on such tape, the portion of such tape that would have been utilized by such visual index is not usable for recording any other content. To the contrary, *Dimitrova* recites:

> Both tapes require a predetermined portion at a selected area on the tape, in this example, the beginning for ease of use, to allow a visual index to be created. For the present example, thirty seconds of "blank" or overwrittable [sic] tape is desired.

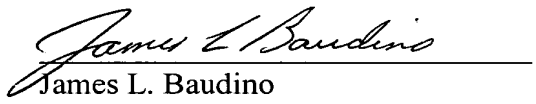
(*Dimitrova*, column 2, lines 41-45) (emphasis added). Thus, *Dimitrova* appears to disclose that because the index may be placed at an "overwrittable [sic]" portion of the tape, such index is being written onto a portion of the tape already containing data. Therefore, such "overwrittable [sic]" portion of such tape is clearly part of the recordable capacity of such tape. Accordingly, *Dimitrova* does not disclose or even suggest the limitations of Applicant's claims.

CONCLUSION

Applicant has demonstrated that the present invention as claimed is clearly distinguishable over the art cited of record. Therefore, Applicant respectfully requests the Board of Patent Appeals and Interferences to reverse the final rejection of the Examiner and instruct the Examiner to issue a notice of allowance of all claims.

No fee is believed due with this Reply Brief. If, however, Applicant has overlooked the need for any fee, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 08-2025 of Hewlett-Packard Company.

Respectfully submitted,



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PATENT APPLICATION

ATTORNEY DOCKET NO. 10010903-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): David H. HANES

Confirmation No.: 3500

Application No.: 09/911,017

Examiner: Zhou, Ting

Filing Date: July 20, 2001

Group Art Unit: 2173

Title: SYSTEM AND METHOD FOR SCENE DETECTION INFORMATION STORAGE

Mail Stop Appeal Brief-Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Sir:

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on **June 1, 2005**. This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

(Note: Extensions of time are not allowed under 37 CFR 1.136(a))

(Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new grounds of rejection.)

No fee is required for filing of this Reply Brief.

If any fees are required please charge Deposit Account 08-2025.

(X) I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450.
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Respectfully submitted,

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